

## R E M A R K S

Applicant has carefully considered the above identified Office Action, and in response thereto is addressing each issue raised by the examiner in the remarks hereinbelow. Applicant has amended claim 12 by adding the word "and." The amendment of claim 12 puts the claim in condition for allowance or appeal.

## Claim Rejection 35 USC 103(a)

Applicant respectfully disagrees with examiner concerning his rejection of claim 1 with the Malkiewicz '591 in view of the Herold '035 patent. Malkiewicz discloses locating the inlet in one end cap and one outlet in the other end cap of the muffler container. Herold discloses locating the inlet in one end of the muffler container and the outlet in the other end of the muffler container. Applicant locates the inlets and outlets in the container portion not in the end caps or in the ends of the container portion.

To make a prima facie case of obviousness examiner must meet all three requirements of MPEP 2143:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings.
- 2) There must be a reasonable expectation of success.
- 3) The prior art reference must teach or suggest all claim limitations.

There is no suggestion or motivation to combine the Herold and Malkiewicz patents, except for hindsight reconstruction.

The Malkiewicz patent discloses a single piece of material for forming a muffler container and a baffle. The Herold patent discloses a complex stamped baffle, which is not fabricated from the same piece of material as either container half. The Malkiewicz and Herold mufflers are completely different from each other, except for parallel exhaust flow. There is no suggestion or motivation to combine two completely different mufflers, other than hindsight reconstruction.

There is no reasonable expectation of success for two reasons. First, the internal construction of Malkiewicz would not allow baffle walls that are oriented at acute angles to each other. The baffle walls must be parallel to each other to have the marginal portion 44 contact the inner wall of the container 34. It would not be obvious to one skilled in the art to modify Malkiewicz to get the angled baffles of Herold.

Second, the combination of Herold and Malkiewicz do not disclose all limitations found in claim 1. The ends or end caps of applicant's container are covered. The ends or end caps of the Herold and Malkiewicz have inlets and outlets formed therein. The inlets and outlets in applicant's invention are formed in the container portion, not in the ends or end caps thereof.

The combination of Herold and Malkiewicz do not teach or suggest all claim limitations. The inlets and outlets in applicant's invention are formed in the container portion, not in the ends or end caps thereof. Inlets and outlets are formed in the ends or end caps of the Herold and Malkiewicz mufflers. All

claims dependent upon a new allowable independent claim are also made allowable.

Applicant respectfully disagrees with examiner concerning his rejection of claim 12 with the combination of Malkiewicz and Herold in view of the Musitano et al. '479 patent. The Musitano et al. patent discloses a tubular container having exhaust inlets formed in the end caps thereof. The Musitano et al. does disclose a fresh air inlet formed in the tubular container, but not an exhaust inlet formed in the tubular container. Applicant locates the inlet in the container portion not in the end caps or in the ends of the container portion.

The location of the inlets and the outlets in the container portion are not mere design choice, but are functional and for packaging reasons. If applicant put the exhaust inlet in one end and the exhaust outlet in the other end, little or no noise reduction would result. A transom of a boat does not afford extra room for large in-line mufflers.

To make a prima facie case of obviousness examiner must meet all three requirements of MPEP 2143. There is no suggestion or motivation to combine the Herold, Malkiewicz and Musitano et al. patents, except for hindsight reconstruction. The Herold, Malkiewicz and Musitano et al. patents all disclose three completely different designs of mufflers. Actually, the Musitano et al. patent discloses a muffler/heater box combination. Warming chamber 28 is used to provide warm air to the passenger compartment. Further, the Musitano et al. patent discloses an

exhaust outlet formed in a muffler container, unlike the Herold and Malkiewicz patent. Accordingly, there is no suggestion or motivation to combine three completely different mufflers, other than hindsight reconstruction.

There is no reasonable expectation of success for three reasons. First, the Musitano et al. teaches away from applicant's invention by disclosing a fresh air inlet in the tubular container and not an exhaust inlet. Second, the combination of Herold, Malkiewicz and Musitano et al. do not disclose all limitations found in claim 12. The ends or end caps of applicant's container are covered. The ends or end caps of Herold, Malkiewicz and Musitano et al. have inlets or outlets formed therein. The inlets in applicant's invention are formed in the container portion, not in the ends or end caps thereof.

Third, adapting the exhaust outlet to be formed in the muffler container of Herold would diminish the performance of the muffler, because there would be fewer baffling stages. Adapting the exhaust outlet to be formed in the muffler container of Herold would unnecessarily complicate the construction of the Malkiewicz of the outlet exhaust. The exhaust outlet would be required to have a complicated bend to exit the muffler container. Further, manufacturing complexity would be introduced by forming and sealing a hole for the outlet exhaust in the curved container side wall of Malkiewicz.

The combination of Herold, Malkiewicz and Musitano et al. do not teach or suggest all claim limitations. The exhaust inlets

in applicant's invention are formed in the container portion, not in the ends or end caps thereof. The exhaust inlets and outlets are formed in the ends or end caps of the Herold, Malkiewicz mufflers. The exhaust inlets are formed in the end caps of the Musitano et al. patent. All claims dependent upon a new allowable independent claim are also made allowable.

Applicant respectfully disagrees with examiner concerning his rejection of claim 32 with the combination of Malkiewicz and Herold in view of the Musitano et al. '479 patent. The location of the exhaust inlets and the outlets in the container portion are not mere design choice, but are functional and for packaging reasons, as previously stated. To make a prima facie case of obviousness examiner must meet all three requirements of MPEP 2143.

There is no suggestion or motivation to combine the Herold, Malkiewicz and Musitano et al. patents, except for hindsight reconstruction. The Herold, Malkiewicz and Musitano et al. patents all disclose three completely different designs of mufflers. The Musitano et al. patent discloses a multiple piece baffle, which is not fabricated from the same piece of material as the muffler container. The Malkiewicz patent discloses a single piece of material for forming a muffler container and a baffle. The Herold patent discloses a complex stamped baffle, which is not fabricated from the same piece of material as either container half. The Malkiewicz, Herold and Musitano et al. mufflers are completely different from each other. Further, the

Musitano et al. patent discloses an exhaust outlet formed in a muffler container, unlike the Herold and Malkiewicz patent. Accordingly, there is no suggestion or motivation to combine three completely different mufflers, other than hindsight reconstruction.

There is no reasonable expectation of success for four reasons. First, the internal construction of Malkiewicz would not allow baffle walls that are oriented at acute angles to each other. The baffle walls must be parallel to each other to have the marginal portion 44 contact the inner wall of the container 34. It would not be obvious to one skilled in the art to modify Malkiewicz to get the angled baffles of Herold. Musitano et al. does not provide an further illumination to the combination of Malkiewicz and Herold. Musitano et al. discloses a multiple piece baffle, which is not fabricated from the same piece of material as the muffler container.

Second, the Musitano et al. teaches away from applicant's invention by disclosing a fresh air inlet in the tubular container and not an exhaust inlet. Third, the combination of Herold, Malkiewicz and Musitano et al. do not disclose all limitations found in claim 32. The ends or end caps of applicant's container are covered. The ends or end caps of Herold, Malkiewicz and Musitano et al. have inlets or outlets formed therein. The inlets in applicant's invention are formed in the container portion, not in the ends or end caps thereof.

Fourth, adapting the exhaust outlet to be formed in the muffler container of Herold or Malkiewicz would diminish the performance of the muffler as previously stated in the claim 12 argument.

The combination of Herold, Malkiewicz and Musitano et al. do not teach or suggest all claim limitations. The exhaust inlets in applicant's invention are formed in the container portion, not in the ends or end caps thereof. The exhaust inlets and outlets are formed in the ends or end caps of the Herold and Malkiewicz mufflers. The exhaust inlets are formed in the end caps of the Musitano et al. patent. All claims dependent upon a new allowable independent claim are also made allowable.

## C O N C L U S I O N

It is respectfully submitted that applicant has responded in a fully satisfactory manner to all matters at issue in this application, and this application is now in condition for allowance. In this regard, applicant has made every effort to comply with the requirements set forth in this Office Action as well as statutory requirements. Accordingly, applicant respectfully requests that the Examiner enter this amendment, allow the claims, and pass this application on to issue.

Respectfully submitted,



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